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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,408	09/17/2003	Nicholas A. Sanders	NAS-001	3191
42532	7590	09/19/2005	EXAMINER	
PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE 14TH FL BOSTON, MA 02110			MERCADO, JULIAN A	
			ART UNIT	PAPER NUMBER
			1745	

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/664,408	Applicant(s) SANDERS, NICHOLAS A.	
	Examiner Julian Mercado	Art Unit 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) 25-79 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-24-05, 12-11-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 29-79 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on August 15, 2005.

Information Disclosure Statement

The IDS filed February 24, 2005 and December 11, 2003 have been considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 at lines 4-5 recites “natural, and commercial” as components of the composite material. This limitation is indefinite as it appears to recite the adjective portion of the noun while the noun or object to be modified itself is omitted.

Claim 14 at line 3 recites a similar limitation to claim 11 above and is therefore rejected under the same grounds.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6, 9 and 19-28 rejected under 35 U.S.C. 102(b) as being anticipated by Kawakami (U.S. Pat. 6,040,087)

Kawakami teaches a hydrogen storage alloy comprising a base material [102] partially coated with a catalyst [103], the base material being partially permeable to the extent that gaseous hydrogen passes therethrough, with said hydrogen being stored in a hollow region [101] disclosed as a core layer. (col. 10 line 13-55) The catalyst is nickel, *inter alia*. (col. 12 line 3-11) A plurality is sintered together to form an electrode. (col. 8 line 66 to col. 9 line 11) The material further comprises aluminum, *inter alia*. (col. 4 line 42)

As to the base material comprising a microbubble, a reading of applicant's specification appears to direct this feature as being equivalent of a microsphere. Figure 1 of Kawakami, which shows a spherical shape of micron size (and hence a "micro" "sphere") is considered to read on this feature.

Regarding controlling the permeability by pressure or temperature or enhancing the rate of transfer of the gaseous element by surface modifications, each of these process limitations has not been given patentable weight, as the limitations being drawn to a process-of-using feature does not give breadth or scope to the product claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kawakami.

With respect to the coating being formed by a coating process such as chemical vapor deposition, *inter alia*, this process limitation has not been given patentable weight as the limitation does not give breadth or scope to the product claim. The claimed product appears to be the same or similar to the prior art product insofar as being a composite material assembly. Notwithstanding, in the event that any differences can be shown by the product of the product-by-process claim 18, such differences would have been obvious to the skilled artisan as a routine modification of the product absent of a showing of unexpected results. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

Claims 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawakami.

With respect to claims 5, 7 and 8 which recite size dimensions including the diameter and wall thickness, it is asserted that absent of evidence that the claimed device performs differently than the prior art device, the claimed device is not patentably distinct from the prior art device.

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In re Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984).

Claims 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawakami in view of Jung (U.S. Pat. 3,607,787)

Kawakami does not explicitly teach the composite to comprise a glass such as silicates. However, Jung teaches silicates as a coating for a battery electrode. (col. 4 line 28-43) The skilled artisan would find obvious to modify Kawakami's invention by employing a silicate for reasons such as obtaining alkali resistance while lowering material costs of manufacturing. (ib.)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Mercado whose telephone number is (571) 272-1289. The examiner can normally be reached on Monday through Friday.

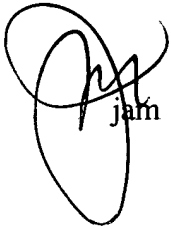
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



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PATRICK JOSEPH RYAN
SUPERVISORY PATENT EXAMINER